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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/229,898 | 01/14/1999 | SIMON MICHAEL ROWE | 1263.0700 | 5189 |

5514 7590 03/25/2004

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

SEALEY, LANCE W

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2671

DATE MAILED: 03/25/2004

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/229,898

Applicant(s)

ROWE ET AL.

Examiner

Lance W. Sealey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the amendment of 8 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-116, 118-129, 131-166, 168-179, 181-192, 195-204 and 207-251 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-42, 44-65, 67-100, 102-116, 118-129, 131-166, 168-192, 195-204 and 207-252 is/are allowed.
- 6) ☒ Claim(s) 43/1, 43/21, 43/22, 66/44, 66/54, 66/55, 101/67 and 101/84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Allowable Subject Matter

1. Claims 1-42, 44-65, 67-100, 102-116, 118-129, 131-166, 168-192, 195-204 and 207-252 are allowed.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. Claims 43/1, 43/21, 43/22, 66/44, 66/54, 66/55, 101/67 and 101/84 are rejected.

3. The examiner is reinstating the § 101 rejection made in Paper No. 15 and responded to by the applicants in Paper No. 16. The rationale the examiner gave for the § 101 rejection in Paper No. 15 was:

4. Patentable subject matter is held to exclude "laws of nature, natural phenomena, and abstract ideas". *Diamond v. Diehr*, 450 U.S. 175, 185, 101 S.Ct 1048, 1056 (1981). The applicants' signal claims 43/1 and 43/21 disclose an abstract idea (a signal) which is not tangibly employed on a computer readable medium. Only an applicant's claims are entitled to the protection of the patent system; therefore claims, if expressing ideas in a mathematical form, must describe something beyond the manipulation of ideas in order to qualify as patentable

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subject matter. *In re Warmerdam*, at 1360. Given the absence of any practical effect or significant independent physical acts, claims 43/1 and 43/21 fail to adequately define the claimed invention within the domain of patentable subject matter.

5. In response, the applicants referred to MPEP 2106(IV)(B)(1)(b) regarding nonfunctional descriptive material, reproducing the following text:

“Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided.

Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer.”

noting that these claims more than adequately provide a functional interrelationship between the signal and “the way in which computing processes are performed”; the language of these claims explicitly state a fundamental relationship between the signal and a method performed by a processing apparatus; and that it has long been recognized that “a signal claim directed to a practical application of electromagnetic energy is statutory,” citing MPEP 2106(IV)(B)(1)(c), which cites *O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 114-119 (1853).


6. However, claims 43/1 and 43/21 are rejected for a simpler reason than the idea that they represent nonfunctional descriptive material: these claims disclose material that is not within any of the classes of inventions deemed statutory by the § 101 statute, namely process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lance Sealey whose telephone number is (703) 305-0026. The examiner can normally be reached Monday-Friday from 7:00 am to 3:30 pm EST.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Zimmerman, can be reached on (703) 305-9798. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.


MARK ZIMMERMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600